



Practitioner's Docket No. U 013711-6

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Hiroyuki ONISHI, et al

Serial No.: 10/009,884

Group No.: 1746

Filed: November 13, 2001

Examiner.: William P. Fletcher, III

For: METHOD FOR SURFACE-TREATMENT, SURFACE TREATED ARTICLE AND DEVICE  
FOR SURFACE TREATMENT

**Commissioner for Patents**

**P. O. Box 1450**

**Alexandria, VA 22313-1450**

**ATTENTION: GROUP DIRECTOR**

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT AFTER  
MAILING DATE OF FINAL ACTION OR NOTICE OF ALLOWANCE  
BUT BEFORE PAYMENT OF ISSUE FEE (37 C.F.R. 1.97(d))**

*NOTE: 37 C.F.R. 1.97: "(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section [i.e., after the mailing date of any final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application], provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:*

- (1) The statement specified in paragraph (e) of this section; and*
- (2) The fee set forth in § 1.17(p)."*

**CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\***

*(When using Express Mail, the Express Mail label number is **mandatory**;  
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

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**37 C.F.R. 1.8(a)**

**37 C.F.R. 1.10\***

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- ☐ transmitted by facsimile to the Patent and Trademark Office, to **(571)-273-8300**

Signature

**CLIFFORD J. MASS**

(type or print name of person certifying)

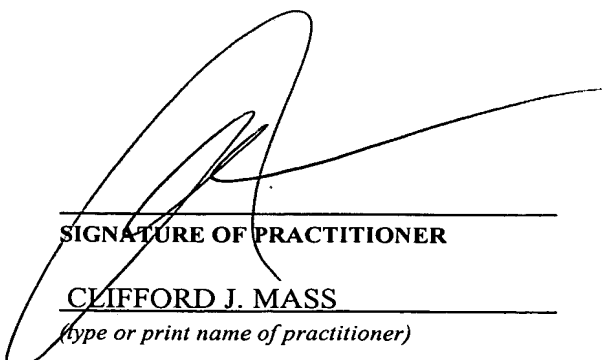
Date: November 21, 2006

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Reg. No. 30086

Tel. No. (212) 708-1890

Customer No.: 00140



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SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS

*(type or print name of practitioner)*

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P.O. Address

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c/o Ladas & Parry LLP  
26 West 61<sup>st</sup> Street  
New York, N.Y. 10023

NOTE: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19. See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.

NOTE: "The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. 1.10." See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.

NOTE: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition:

"If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement."

NOTE: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 C.F.R. 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.

NOTE: "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an

information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

**NOTE:** The mere absence of an item of information for a foreign patent office communication is not intended to represent an opportunity to delay the submission of a item known more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under Section 1.56. 62 Fed. Reg. 53,131, 53,150 (Oct. 10, 1997).

**NOTE:** The IDS is considered filed as of the date it is received in the PTO, or on an earlier date of mailing of transmission if done so with a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. § 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. § 1.10. See § 609B(5), M.P.E.P., 8<sup>th</sup> Edition.

**NOTE:** "The certification under Section 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.

**NOTE:** "The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**NOTE:** "Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. Section 1.56(d) and

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. Section 1.56(c).

## IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT FOR WHICH THIS STATEMENT IS BEING MADE

1. This statement is being made for the Information Disclosure Statement  
☒ [X] accompanying this statement.  
☐ [ ] filed \_\_\_\_\_  
Date

## STATEMENT

2. I, the person(s) signing below state:

that each item of information contained in the information disclosure statement was **first** cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

**NOTE:** The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office."

**OR**

that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(2).

**NOTE:** "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

**IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT**

3. The person making this statement is

*(check each applicable item)*

(a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
**SIGNATURE OF INVENTOR**

\_\_\_\_\_  
*(type name of inventor who is signing)*

(b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56(c)) and who signs below.

\_\_\_\_\_  
**SIGNATURE OF PERSON MAKING STATEMENT**

\_\_\_\_\_  
*(type name of person who is signing)*

\_\_\_\_\_  
Address of person who is signing

(c) ☒ the practitioner who signs below on the basis of the information:

*(check each applicable item)*

- ☐ supplied by the inventor(s).
- ☒ supplied by an individual designated in Section 1.56(c).
- ☒ in the practitioner's file.

Reg. No. 30086

Tel. No. (212) 708-1890

Customer No.: 00140



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SIGNATURE OF PRACTITIONER

---

CLIFFORD J. MASS

*(type or print name of practitioner)*

---

P.O. Address

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c/o Ladas & Parry LLP  
26 West 61<sup>st</sup> Street  
New York, N.Y. 10023



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Hiroyuki ONISHI, et al

Serial No.: 10/009,884

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For: METHOD FOR SURFACE-TREATMENT, SURFACE TREATED ARTICLE AND  
DEVICE FOR SURFACE TREATMENT

Attorney Docket No.: U 013711-6

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT**

We draw the attention of the Examiner to the attached English-language version of an Action or International-type Search Report from a foreign office in respect of counterpart JP Application No. 2001-566906 that indicates the degree of relevance found by the foreign office. The Action or Search Report makes consideration of any non-English art required. MPEP 609.

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**CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10\***

*(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)*

I hereby certify that, on the date shown below, this correspondence is being:

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**37 C.F.R. 1.8(a)**

- ☒ with sufficient postage as first class mail.

**37 C.F.R. 1.10\***

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**TRANSMISSION**

- ☐ transmitted by facsimile to the Patent and Trademark Office. to (571)-273-8300

Date: November 21, 2006

Signature

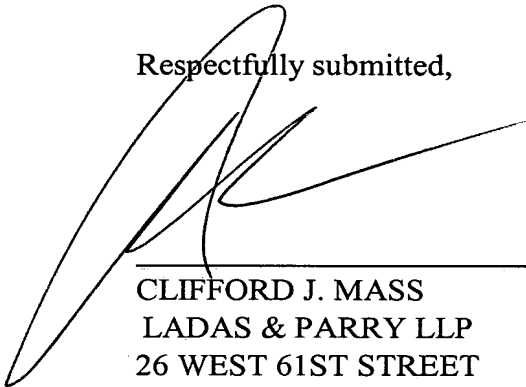
CLIFFORD J. MASS

*(type or print name of person certifying)*

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"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

Form PTO-1449 is also attached with reference copies (first page only for U.S. patent publications).

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to be 'CJ Mass', is written over a horizontal line.

CLIFFORD J. MASS  
LADAS & PARRY LLP  
26 WEST 61ST STREET  
NEW YORK, NEW YORK 10023  
REG. NO.30,086(212)708-1890



FORM PTO-1449

U. S DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

ATTY. DOCKET NO.

SERIAL NO.

U 013711-6

10/009,884

INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT

(Use several sheets if necessary)

APPLICANT

Hiroyuki ONISHI et al.

FILING DATE

GROUP

November 13, 2001

1746

## U.S. PATENT DOCUMENTS

EXAMINER INITIALS	REFERENCE DESIGNATION	DOCUMENT NUMBER	DATE	NAME	FILING DATE IF APPROPRIATE
	AA				
	AB				
	AC				
	AD				
	AE				
	AF				
	AG				
	AH				
	AI				
	AJ				
	AK				

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AL	61-249755	11/1986	JP		X
	AM	7-96603	11/1995	JP		X
	AN	8-281933	10/1996	JP		X
	AO	9-226154	09/1997	JP		X
	AP					

## OTHER ART (Including Author, Title, Date, Pertinent Dates, Etc.)

	AQ	Patent Abstracts of Japan of 61-249755 dated November 6, 1986
	AR	Patent Abstracts of Japan of 7-96603 dated April 11, 1995
	AS	Patent Abstracts of Japan of 8-281933 dated October 29, 1996
	AT	Patent Abstracts of Japan of 9-226154 dated September 2, 1997

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.